

### **REMARKS**

The Office Action dated April 28, 2009, (hereinafter "Office Action") has been received and carefully considered. In this response, claims 1 and 19 have been amended. Claims 5 and 22 have been canceled and incorporated into independent claims 1 and 19, respectively. No new matter has been added. Entry of the amendments to claims 1 and 19 is respectfully requested. Reconsideration of the current rejections in the present application is also respectfully requested based on the following remarks.<sup>1</sup>

#### **I. THE OBVIOUSNESS REJECTION OF CLAIMS 1-30**

On page 4 of the Office Action, claims 1-11, 15-25 and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Callahan, in view of U.S. Patent No. 6,856,973 to Bott ("Bott"). On page 11 of the Office Action, claims 12-14 and 26-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Callahan, in view of Bott, and further in view of U.S. Patent Application Publication No. 2002/0129221 to Borgia *et al.* ("Borgia"). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content

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<sup>1</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions made by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Regarding claim 1, the Office Action asserts that Callahan discloses the claimed invention. Applicants respectfully disagree. However, in order to forward the present application toward allowance, Applicants have amended claims 1 to more specifically define the claimed invention, and specifically those features that further differentiate the claimed invention from Callahan, as well as other cited references. In particular, Applicants respectfully submit that Callahan fails to disclose, or even suggest, among other things, the following claim recitations of claim 5 (which have now been incorporated into claim 1 in modified form) as follows:

wherein the step of assessing the business impact on the enterprise further comprises:  
assessing an impact on external customers of the enterprise resulting from the  
degradation of the services from the outside service provider;

assessing an impact on internal customers of the enterprise resulting from the degradation of the services from the outside service provider;

assessing a financial impact resulting from the degradation of the services from the outside service provider;

assessing an allowable time period that the degradation of the services from the outside service provider can last; and

assessing an impact on regulatory obligations resulting from the degradation of the services from the outside service provider

Applicants respectfully submit that Callahan (or any of the other cited references) teaches or suggests, alone or in combination, the claimed step of assessing the business impact on the enterprise which comprises: (1) assessing an impact on external customers of the enterprise resulting from the degradation of the services from the outside service provider; (2) assessing an impact on internal customers of the enterprise resulting from the degradation of the services from the outside service provider; (3) assessing a financial impact resulting from the degradation of the services from the outside service provider; (4) assessing an allowable time period that the degradation of the services from the outside service provider can last; and (5) assessing an impact on regulatory obligations resulting from the degradation of the services from the outside service provider. Applicant particularly notes that the Office Action fails to cite to a specific excerpt from Callahan which teaches or suggests the step of “assessing an allowable time period that the degradation of the services from the outside service provider can last.” As stated in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros.

v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants respectfully submit that none of the other cited references make up for Callahan's deficiencies in this regard.

Accordingly, it is respectfully submitted that claim 1 is allowable over Callahan and the other cited references. Regarding claim 19, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 19. Accordingly, it is respectfully submitted that claim 1 is allowable over Callahan and the other cited references for the same reasons as set forth above with respect to claim 1.

Regarding claims 1-4, 6-18 and 20, 21 and 23-30, these claims are dependent upon independent claim 1 or 19. Thus, since independent claims 1 and 19 should be allowable as discussed above, claims 1-4, 6-18 and 20, 21 and 23-30 should also be allowable at least by virtue of their dependency on independent claim 1 or 19. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. The rejection of claims 12-14 and 26-28 were under 35 U.S.C. §103(a) as being unpatentable over Callahan, in view of Bott, and further in view of Borgia is moot in view of the above arguments and claim amendments.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejections of claims 1-30 be withdrawn.

## II. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the

present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

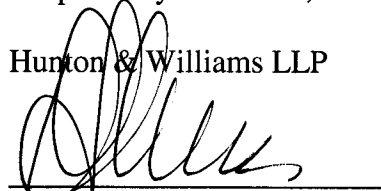
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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